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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,025	12/29/2000	Jonathan W. Hubbs	29092.00011	7715

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EXAMINER

BRUNSMAN, DAVID M

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 09/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/751,025

Applicant(s)

HUBBS, JONATHAN W.

Examiner

David M Brunsman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 and 41-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 and 41-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 21 August 2003 has been entered.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-38 and 41-46 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The instant specification limits the invention to products that are firm, malleable enough to allow cleat penetration and easy repair, resistant to being pulled up in clumps, dust free and water resistant.

The Background teaches that other combinations of soil or clay and an organic binder fail to perform the functions required of the invention such that a significant number of combinations that otherwise fall within the scope of the claims are inoperable. See, *In re Cook*, 169 USPQ 451 and *In re Fisher*, 166 USPQ 18. The instant specification does not contain teaching how one of ordinary skill in the art could choose or predict which waxes are capable of making surface materials malleable and adding cohesiveness between particles. Simply reciting the desired result is not sufficient to adequately enable the claims. See, *In re Corkill*, 226 USPQ 1005.

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Page 6, lines 11-13 of the specification require that the particular wax used must be capable of making the surface malleable and add cohesiveness, suggesting that some waxes would be inoperative. The only teaching allowing one of ordinary skill in the art to determine which waxes are operable is the selection of the two particular waxes described in the Tables of pages 5 and 6. Without evidence that one of ordinary skill in the would expect most waxes to perform adequately or evidence the one would have been able to select operable waxes without undue experimentation the enabling scope of the disclosure is limited to waxes having properties similar to IGI 422 and IGI 1266U. Thus, in view of the evidence currently of record, claims 1-38 and 41-46 would fail to meet the enablement requirements of 35 U.S.C. 112, first paragraph. The examiner has established a reasonable basis, as set forth above, in pointing to specific compositions having the ingredients recited in the instant claims which are described by the instant specification itself as failing to perform the required functions.

In the response filed with the Request for Continued Examination applicant mischaracterizes examiner's arguments. The examiner does not argue that the "claims do not list the benefits of the invention", but that the instant claims are not limited to compositions which exhibit the basic and novel characteristics of the invention, as set forth in the original specification, and are not limited to the enabled disclosure. The examiner has explicitly noted "simply reciting the desired result is not sufficient to adequately enable the claims." *In re Corkill*, 226 USPQ 1005.

No evidence has been presented that the knowledge required to determine if a particular product falls within claimed scope is inherent to those skilled in the art how to make the invention without undue experimentation. The examiner has presented specific and reasonable

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basis that compositions having all ingredients recited in the instant claims fail to perform the functions required by the instant specification. Applicants argue such compositions are different than the claimed composition, but does not explicitly set forth those *differences* in argument, specification or the instant claims. There is no teaching showing one of ordinary skill in the art could determine which waxes would “make the surface material malleable” and “add cohesiveness to the particles” without undue experimentation.

Claims 37-38 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 4925493.

The reference teaches a composition for surfacing horse racing tracks comprising soil made up of clay, silt, sand and organic matter and, wax. The sand recited is considered to anticipate decomposed granite. Because of the similar intended use, the composition would be expected to exhibit similar properties. Thus, reasoning for the examiner’s assertion that similar properties would be exhibited has been set forth. Applicant has submitted no rebuttal of that reasoning. Examiner agrees that page 1, lines 16-23 of the instant specification teach decomposed granite is a species of the soil including sand and silt.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M Brunsman whose telephone number is 703-308-3454. The examiner can normally be reached on M, W, F, Sa; 6:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 703-308-3823. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

David M Brunsman
Primary Examiner
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DMB

